

Appl. No. 10/826,272
Amendment dated August 2, 2007
Reply to Office Action of April 18, 2007

AMENDMENTS TO THE DRAWINGS:

The attached sheets of drawings include changes/corrections to Figures 1-24. These sheets, which include Figures 1-24, replace the original sheets including Figures 1-24.

Attachment: twelve (12) replacement sheets

REMARKS

In the April 18, 2007 Office Action, the drawings and disclosure were objected to and claims 1-31 stand rejected in view of prior art. Claims 1-10 also were rejected for failing to indicate and claim particularly and distinctly the subject matter that Applicant regards as the invention. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the April 18, 2007 Office Action, Applicant has amended the drawings, specification and claims 1, 2, 6, 11, 12, 14, 15, 17-19, 22, 26 and 28 as indicated above. Thus, claims 1-31 are pending, with claims 1, 11, 19 and 22 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Election of Species

In paragraphs 1 and 2 of the Office Action, Applicant's election without traverse of the species illustrated in Figures 1-16 was acknowledged. None of claims 1-31 were withdrawn from consideration. Claims 32-36 were previously cancelled.

Drawings

In paragraph 3-4 of the Office Action, the drawings were objected to as failing to comply with 37 CFR §1.84 and for informalities noted on form PTO-948. In response, Applicant has filed herewith twelve replacement sheets of drawings with changes/corrections made thereto. Based on the attached replacement sheets of drawings and the following comments, withdrawal of the drawing objections are respectfully requested.

In response to paragraphs 3(a) and 3(b) of the Office Action, the attached replacement sheets of drawings are believed to have lines, numbers and letters that are uniformly thick and well defined, clean, durable and black in accordance with 37 CFR §1.84(l). Also, the attached replacement sheets of drawings are believed to have lines of hatching that are sufficiently spaced apart in accordance with 37 CFR §1.84(h)(3). Based on the above Amendments and comments, Applicant respectfully requests that these objections be withdrawn.

In response to paragraph 3(c) of the Office Action, the view numbers have been changed from "Fig. 1", etc. to --FIG.1--, etc. While Applicant acknowledges that 37 CFR §1.84(u)(1) indicates that the abbreviation "FIG." should be used, Applicant also notes that this is a grammatically incorrect way to abbreviate the word "Figure". Thus, many patent draftsmen have used the abbreviation "Fig." in patent applications for many years without objection from the USPTO, as evidenced by the thousands of U.S. patents issued that use the abbreviation "Fig." in identifying the views of the drawings. In fact, *The Guide for Preparation of Patent Drawings* shows that the use of "Fig." is acceptable. See Example 18 on pages A4-38 and A4-39 (copy attached) of the *Guide for Preparation of Patent Drawings*. Based on the above Amendments and comments, Applicant respectfully requests that this objection be withdrawn.

In response to paragraph 3(d) of the Office Action, Applicant respectfully traverses this objection. Applicant notes that 37 CFR §1.84(h)(1) indicates that "Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts *are permissible*. When an exploded view is shown in a figure which *is one the same sheet as another figure*, the exploded view *should* be placed in brackets." (emphasis added) In other words, 37 CFR §1.84(u)(2) identified in this section of the Office Action is believed to be directed to a common practice in other countries where brackets, parenthesis or a combination of both are placed around each view number such as 【FIG. 1】 , [FIG. 1], (FIG. 1), etc. Note that 37 CFR §1.84(u)(2) uses the plural form of the word "bracket", and that the interpretation of 37 CFR §1.84(u)(2) used in the Office Action is inconsistent with 37 CFR §1.84(h)(1) and the *Guide for Preparation of Patent Drawings*. See Example 8 on pages A4-18 and A4-19 (copy attached) of the *Guide for Preparation of Patent Drawings*. Thus, this objection is respectfully traversed. Based on the above Amendments and comments, Applicant respectfully requests that this objection be withdrawn.

In response to paragraph 3(e) of the Office Action, Applicant has amended the specification to identify the T-shaped longitudinal projection 68 as the mating mounting structure that cooperates with the switch mounting structure 38, as indicated above. In other words, the protrusion 68 has been identified as the mating mounting structure. Accordingly, the drawings are now believed to fully comply with MPEP 608.01(g). Based on the above Amendments and comments, Applicant respectfully requests that this objection be withdrawn.

Specification Objections

In paragraphs 5 and 6 of the Office Action, the disclosure was objected to for various informalities. In response, Applicant has amended the specification to identify T-shaped longitudinal projection 68 as the mating mounting structure that cooperates with the switch mounting structure 38, as indicated above. In other words, the protrusion 68 has been identified as the mating mounting structure. Additionally, the grammatical error in claim 12 has been corrected. Based on the above Amendments and comments, Applicant respectfully requests that these objections be withdrawn.

Claim Rejections - 35 U.S.C. §112

In paragraph 8 of the Office Action, claims 1-10 were rejected under 35 U.S.C. §112, second paragraph. In response, Applicant has amended claims to delete the alleged indefinite language. Specifically, Applicant has removed the language related to the switch portion being "removeable" from the mounting portion. Applicant believes that the claims now comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections is respectfully requested.

Rejections - 35 U.S.C. § 102

In paragraphs 9-12 and 16-18 (pages 4-11 and 13-14) of the Office Action, the following claims are rejected under 35 U.S.C. §102 as follows:

- Rejection 1 - Claims 1-7 and 11-18 stand rejected under 35 U.S.C. §102(b) as being anticipated by EP Patent Publication No. 1 375 325 (Ichida et al.);
- Rejection 2 - Claims 1, 8-10 and 22-31 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,991,081 (Uno et al.);
- Rejection 3 - Claims 1 and 22 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,698,307 (Wesling et al.); and
- Rejection 4 - Claim 11 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,305,241 (Masui et al.).

In response, Applicant has amended independent claims 1, 11 and 22 to more clearly define the present invention over the prior art of record.

Independent Claim 1

Independent claim 1 now requires a mounting portion including a tubular clamping member configured to be selectively clamped onto a bicycle handlebar and a switch mounting structure fixedly coupled to the tubular clamping member, and an electrical shift control switch portion including a mating mounting structure coupled to the switch mounting structure and an operating member arranged and configured to move relative to the mounting portion between a neutral position and a first actuating position, the mating mounting structure of the electrical shift control switch portion cooperating with the switch mounting structure such that the electrical shift control switch portion is slidable relative to the mounting portion between a detached position and a retained position when a fastener is removed and such that the electrical shift control switch portion is non-movably attached to the mounting portion when the fastener is installed and the electrical shift control switch portion is in the retained position without removing the mounting portion from the bicycle handlebar. Clearly, this structure is **not** disclosed or suggested by the Ichida et al. publication, the Uno et al. patent, the Wesling et al. patent or any other prior art of record.

With respect to the rejection of independent claim 1 based on the Ichida et al. publication, the so-called electrical shift control switch portion 40 is attached to the so-called mounting portion 41 in a fixed manner (e.g., welded by heat or adhesive, or attached using a fastener such as a screw). See paragraph [0039] of the Ichida et al. publication. In the drawings, the so-called electrical shift control switch portion 40 appears to be integral with the so-called mounting portion 41. In any case, the Ichida et al. publication does not disclose or suggest ***a slidable arrangement between a detached position and a retained position***, as now claimed. A retained position is believed to be a position where the switch is retained with the mounting portion (i.e., prevented from falling off except in the sliding direction). Thus, the Ichida et al. publication fails to disclose or suggest the unique arrangement set forth in independent claim 1, as now amended.

With respect to the rejection of independent claim 1 based on the Ueno et al. patent, this reference suffers from deficiencies similar to the Ichida et al. publication. Specifically, in the Ueno et al. patent, one of the switches is fixedly attached to the brake hood in a permanent manner, and another switch is attached to the brake lever using a pair of bolts in a relatively permanent manner. In other words, the Ueno et al. patent fails to disclose or

suggest *a slidable arrangement between a detached position and a retained position of an electrical shift control switch relative to a mounting portion*, as now claimed. A retained position is believed to be a position where the switch is retained with the mounting portion (i.e., prevented from falling off except in the sliding direction). Thus, the Ueno et al. patent fails to disclose or suggest the unique arrangement set forth in independent claim 1, as now amended.

With respect to the rejection of independent claim 1 based on the Wesling et al. patent, this reference suffers from deficiencies similar to the Ichida et al. publication and the Uno et al. patent. Specifically, in the Wesling et al. patent, the switch is either fixedly attached to the so-called mounting portion (14, 26) or completely removed. In other words, the Wesling et al. patent fails to disclose or suggest *a slidable arrangement between a detached position and a retained position of an electrical shift control switch relative to a mounting portion*, as now claimed. A retained position is believed to be a position where the switch is retained with the mounting portion (i.e., prevented from falling off except in the sliding direction). Thus, the Wesling et al. patent fails to disclose or suggest the unique arrangement set forth in independent claim 1, as now amended.

It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Applicant respectfully submits that claim 1, as now amended, is not anticipated by the Ichida et al. publication, the Uno et al. patent, the Wesling et al. patent or the other prior art of record. Accordingly, withdrawal of these rejections of independent claim 1 is respectfully requested.

Applicant believes that the dependent claims 2-10 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not anticipate the independent claim 1, neither does the prior art anticipate the dependent claims 2-10.

Independent Claim 11

Independent claim 11 now requires a first shift control device including a first mounting portion having a first tubular clamping member configured to be selectively clamped onto a bicycle handlebar and a first electrical shift control switch attached to the first tubular clamping member of the first mounting portion, and a bicycle computer unit including

a display screen being directly supported by the first tubular clamping member of the first mounting portion such that the bicycle computer unit is only indirectly supported by the bicycle handlebar. Clearly, this structure is **not** disclosed or suggested by the Ichida et al. publication, the Masui et al. patent or any other prior art of record.

With respect to the rejection of independent claim 11 based on the Ichida et al. publication, Applicant notes that the so-called bicycle computer unit 20 is directly supported on the handlebar 16 in a spaced arrangement from the so-called first mounting portion 41 in the Ichida et al. publication. In other words, the Ichida et al. publication **does not disclose** a bicycle computer unit including a display screen being directly supported by the first tubular clamping member of the first mounting portion such that the bicycle computer unit is only indirectly supported by the bicycle handlebar, as now claimed. Thus, the Ichida et al. publication fails to disclose or suggest the unique arrangement set forth in independent claim 11, as now amended.

With respect to the rejection of independent claim 11 based on the Masui et al. patent, Applicant notes that, contrary to the position of the Office Action, this reference lacks a first electrical shift control switch attached to the first tubular clamping member whatsoever. Specifically, the so-called electrical shift control switch *portion* is merely a display in this patent. In other words, the Masui et al. patent **does not disclose a first electrical shift control switch attached to the first tubular clamping member of the first mounting portion**, as now claimed. Thus, the Masui et al. patent fails to disclose or suggest the unique arrangement set forth in independent claim 11, as now amended.

It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Therefore, Applicant respectfully submits that claim 11, as now amended, is not anticipated by the Ichida et al. publication, the Masui et al. patent or the other prior art of record. Accordingly, withdrawal of these rejections of independent claim 11 is respectfully requested.

Applicant believes that the dependent claims 12-18 are also allowable over the prior art of record in that they depend from independent claim 11, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not anticipate the independent claim 11, neither does the prior art anticipate the dependent claims 12-18.

Independent Claim 22

Independent claim 22 now requires, *inter alia*, a mounting portion including a tubular clamping member configured to be selectively clamped onto a bicycle handlebar, the tubular clamping member having a first attachment end, a second attachment end and a band section extending between the first and second attachment ends to form a split between the first and second attachment ends, the tubular clamping member being arranged and configured such that the first and second attachment ends move toward each other to reduce an effective inner diameter of a curved mounting surface of the band section, and an electrical shift control switch portion including an operating member disposed on an opposite side of a plane from the split, the plane passing through a center axis of the handlebar and being perpendicular to the operating axis. Clearly, this structure is **not** disclosed or suggested by the Uno et al. patent, the Wesling et al. patent or any other prior art of record.

With respect to the rejection of independent claim 22 based on the Uno et al. patent, this reference fails to disclose the claimed arrangement of tubular clamping member with a split. Also, this reference fails to disclose or suggest an operating member and split arranged on opposite sides of a plane, as now claimed. Rather, in the Uno et al. patent, the so-called mounting portion (40, 42) uses a tubular bracket 42 that moves laterally relative to the handlebar center axis toward the brake hood bracket 40 in response to movement of a fastener to secure the brake hood bracket 40 to the handlebar. The inner diameter of the tubular bracket 42 is **not** reduced during attachment. Moreover, this reference does not disclose a split as claimed whatsoever. Thus, the Uno et al. patent fails to disclose or suggest the unique arrangement set forth in independent claim 22, as now amended.

With respect to the rejection of independent claim 22 based on the Wesling et al. patent, this reference suffers from deficiencies similar to the Uno et al. patent. Specifically, in the Wesling et al. patent, the member 14 lacks a split whatsoever. While it appears that the member 26 may disclose a split (unnumbered and not explained in detail), the potential split is located on the same side of a plane passing through the center of the handlebar perpendicular to the operating axis as the so-called operating member 34. Thus, the Wesling et al. patent fails to disclose or suggest the unique arrangement set forth in independent claim 22, as now amended.

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It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Therefore, Applicant respectfully submits that claim 22, as now amended, is not anticipated by the Uno et al. patent, the Wesling et al. patent or any other prior art of record. Accordingly, withdrawal of these rejections of independent claim 22 is respectfully requested.

Applicant believes that the dependent claims 23-31 are also allowable over the prior art of record in that they depend from independent claim 22, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not anticipate the independent claim 22, neither does the prior art anticipate the dependent claims 23-31.

Rejections - 35 U.S.C. § 103

In paragraph 15 of the Office Action, claims 11, 12, 15-17 and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Ueno et al. patent. In response, Applicant traverses this rejection based on 35 U.S.C. §103(c). Specifically, U.S. Patent No. 6,991,081 (Uno et al.) and the instant application were, at the time the invention was made, owned by, or subject to an obligation of assignment to Shimano, Inc. Thus, as set forth in under 35 U.S.C. §103(c), MPEP 706.02(l)(1) and MPEP 706.02(l)(2), U.S. Patent No. 6,991,081 (Uno et al.) is disqualified as prior art under 35 U.S.C. §103(a). Accordingly, withdrawal of this rejection is respectfully requested.

Allowable Subject Matter

Even though no allowable subject matter was indicated in the outstanding Office Action, Applicant believes claims 19-21 are now in condition for allowance. Specifically, these claims were only rejected under 35 U.S.C. §103(a) based on U.S. Patent No. 6,991,081 (Uno et al.), which is disqualified as prior art under 35 U.S.C. §103(a), as explained above. Accordingly, claim 19 has been amended to place this claim in independent form to accept this apparent allowable subject matter.

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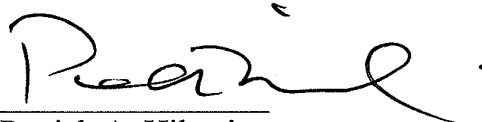
Prior Art Citation

In the Office Action, additional prior art references were made of record. Applicant believes that these references do not render the claimed invention obvious.

* * *

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-31 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,



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Example 8

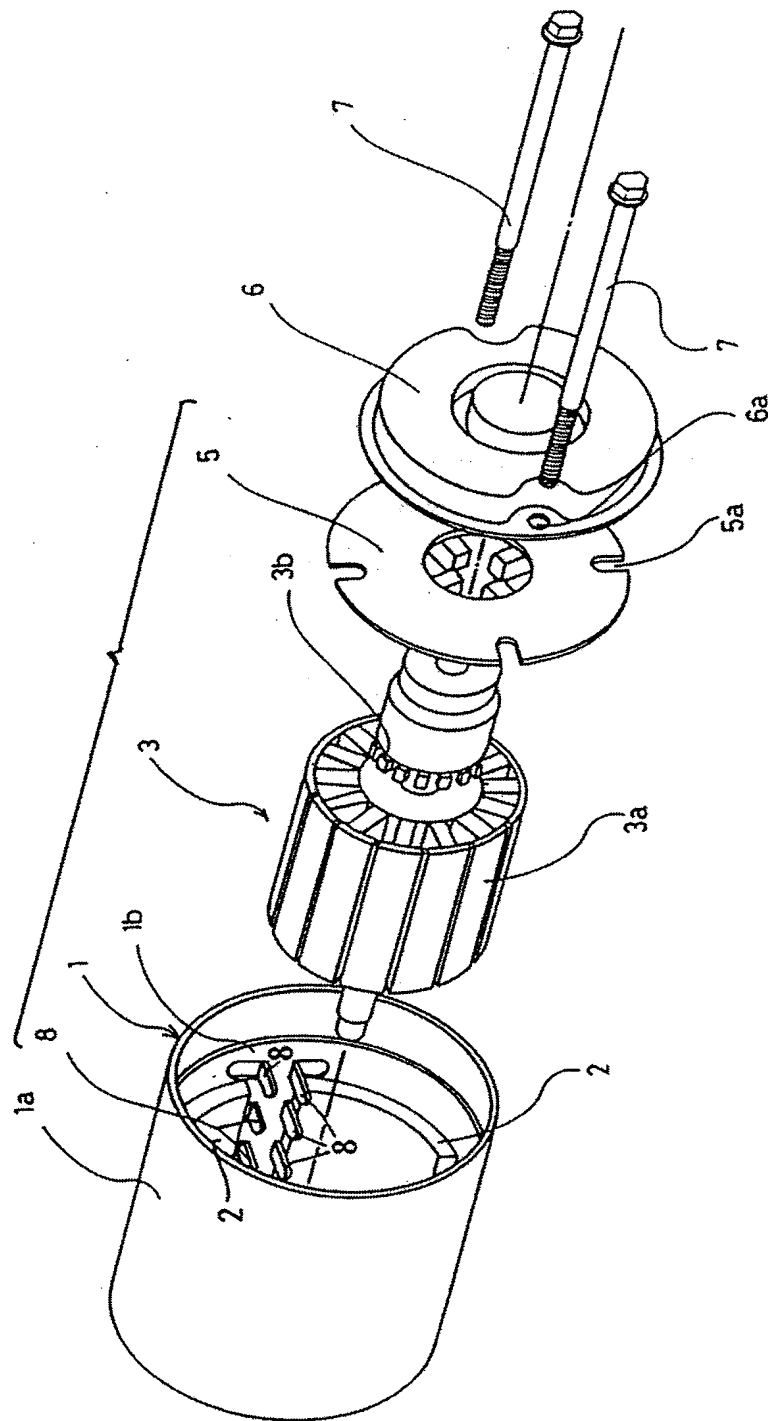
Example 8 is an illustration of an exploded view. Although brackets are not required, the example illustrates the proper use of a bracket to delineate the exploded view. The drawing meets the requirements of

37 CFR 1.84(h)(1) Exploded views.

Additionally, Example 8 illustrates the requirements of

Paragraph (a)(1)	Black ink.
Paragraph (i)	Arrangement of views.
Paragraph (l)	Character of lines, numbers, and letters.
Paragraph (p)(1)	Numbers, letters, and reference characters.
Paragraph (q)	Lead lines.
Paragraph (r)(1)	Arrows.
Paragraph (u)	Numbering of views.

FIG. 2



Example 8
Paragraph (h)(1) Exploded views.

Example 18

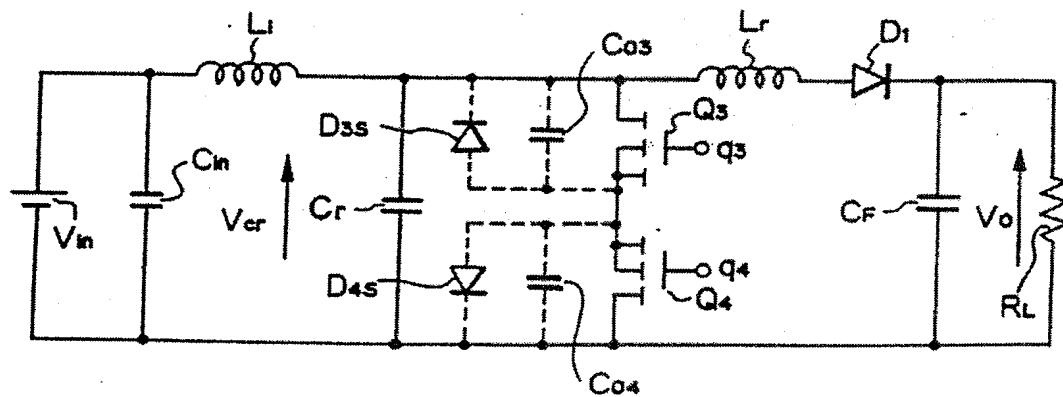
Example 18 illustrates the use of acceptable symbols—in this instance, the use of common electrical symbols. The drawing meets the requirements of

37 CFR 1.84(n) Symbols.

Additionally, Example 18 illustrates the requirements of

Paragraph (a)(1)	Black ink.
Paragraph (i)	Arrangement of views.
Paragraph (l)	Character of lines, numbers, and letters.
Paragraph (p)	Numbers, letters, and reference characters.
Paragraph (q)	Lead lines.
Paragraph (r)	Arrows.
Paragraph (u)	Numbering of views.

Fig. 5



Example 18
Paragraph (n) Symbols.